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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/570,483   | 03/01/2006  | Kaoru Haruki         | F-9034              | 9195             |
| 28107  | 7590        | 09/22/2009           | EXAMINER            |                  |
| JORDAN AND HAMBURG LLP<br>122 EAST 42ND STREET<br>SUITE 4000<br>NEW YORK, NY 10168 |             |                      |                     | REICHLE, KARIN M |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 3761   |             |                      |                     |                  |
|  |             |                      | MAIL DATE           | DELIVERY MODE    |
|  |             |                      | 09/22/2009          | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/570,483             | HARUKI ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Karin M. Reichle       | 3761                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 August 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,6 and 10-12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,6 and 10-12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 06 August 2009 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/13/09</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8-6-09 has been entered.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### **For Example:**

### ***Drawings***

2. The drawings were received on 8-6-09. These drawings are approved.

### ***Description***

3. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification

are: page 1, lines 10-24, the paragraph bridging pages 9-10, page 15, second and third full paragraphs, page 18, second full paragraph and the paragraph bridging pages 18-19.

4. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims should be commensurate, see MPEP 608.01(d), e.g. where is the process set forth in the Summary claimed in the claims? 2) In the paragraph bridging pages 23-24, first sentence, “as shown in FIG. 8(a),” should be moved to the beginning of the sentence after “More specifically,” to avoid confusion.

5. The amendment filed 8-6-09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the abstract, second sentence.

Applicant is required to cancel the new matter in the reply to this Office Action.

The abstract, second sentence, now its forth the diaper main body has indicia indicating a size of the diaper main body and/or indicating a side of the front abdomen portion or the back portion. While the originally filed application set forth identification information including a size and a front or back side of the diaper main body, this is not what is claimed, i.e. a side of the front portion or back portion is not the same as a front or back side of the diaper main portion. If Applicant maintains such language, the portion of the original specification which provides support commensurate in scope therewith should be set forth.

***Claim Objections***

6. Claims 1, 6 and 10-12 are objected to because of the following informalities: Claim 1, line 19, “abdomin” should be --abdomen--. Claim 12, lines 4-5, i.e. “and is absent...”, include numerous grammatical errors. Claim 11 is considered dependent from claim 1. However, the preamble of claim 11, i.e. “An assemblage of diapers”, is inconsistent with that of claim 1, i.e. “A folded disposable diaper”. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. Claims 1, 6 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, lines 31-32 of claim 1 are unclear/inconsistent, i.e. if the indicia (note such is not claimed as “said a least a portion of said indicia”) is already disposed on the body portions, how are they “extended to” additionally, i.e. they are already disposed there, and extended from where?

8. Claims 1, 6 and 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See claim 1, lines 17-19 and the discussion in paragraph 5 supra.

***Claim Language Interpretation***

9. Claims 1, 6 and 10-12, see, e.g., lines 12-16, 20-27 and 31-32 of claim 1, as best understood, and claim 10, are product by process claims, see MPEP 2113, i.e. [E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Also, lines 20-30 do not set forth when such folding over takes place. Therefore, the end product of claim 1 is considered to the structure set forth on lines 1-19 (It is noted with regard to the waist and leg-hole elastics, it is not clear what end structure would result from attaching in an expanded state, e.g. could be gathered or not) having a fold as set forth on lines 33, 23-27 and 31-32, and first and second body portions overlaying each other at some time having the function, capability or property set forth on lines 27-30. The end product of lines 31-32 further in light of the discussion in paragraph 7 supra, is considered to be indicia positioned/disposed/extending on both portions. It is noted that the longitudinal extents of the front, rear and crotch portions relative to the overall extent of the main body have not been set forth. With regard to claim 1, also see paragraph 8 supra as well as MPEP 2163.06, I. The end product of claim 6 is considered to require the leg hole elastic members not extend into some portion/area having indicia thereon. The end product of claim 10 is considered to require printing of the indicia, i.e. at least a portion of the indicia in ink, on the diaper main body ( It is noted that the dictionary defines “printed” as “lettering or other impressions produced in ink

from type by a printing press or other means"). Due to the lack of clarity discussed supra in paragraph 6, claim 11 is considered to require a stack of the diapers of claim 1 with the function, capability or property set forth on lines 4-5. It should be noted that "a side" does not require a particular side or the same side with regard to each of the diapers. Due to the lack of clarity discussed supra in paragraph 6, claim 12 is considered to require each leg hole elastic member include two discontinuous sections with an area therebetween in which at least part of the indicia is disposed. Terminology other than that explicitly defined will be interpreted according to their usual, e.g., dictionary, definition.

***Claim Rejections - 35 USC §/103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1, 6 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCA 'PCT '845 in view of Cammorata et al '162 and MacDonald '665.

Claim 1: See Claim Language Interpretation section supra, hereinafter also referred to as CLI, and '845 at the Figures, esp. 1 and 4, the abstract, page 1, lines 3-7, page 2, lines 25-32, page 3, lines 1-3, 8-9 and 23 et seq, page 4, lines 1-3 and 25 et seq, page 5, lines 1-2, and 10 et seq, page 6, lines 4-12 and 18-25 and its claims, i.e. '845 teaches a folded, see page 6, lines 20-25, disposable diaper, see Figure 1, comprising a diaper main body 1 having a front abdomen portion 5, a back portion 6, and a crotch portion 7 interconnecting the front abdomen portion and the back portion, the crotch portion 7 having opposing side edges formed as leg hole sections which are between the abdomen portion and the back portion and define leg hole, see Figure 1,

the crotch portion extending widthwise between the leg hole sections, see Figure 1, the front abdomen portion having opposing abdomen side edges and the back portion having opposing back side edges, see Figure 1, the abdomen side edges being respectively joined to corresponding ones of the back side edges to define a waist opening, see the paragraph bridging pages 4-5 and note the claim does not require permanent joining nor a pant diaper, the diaper main body being provided with an absorbent main body 4 at the crotch portion, a leg-hole elastic member, i.e. at least one member of each 12, attached along each of the leg hole sections, see CLI supra, the diaper main body having indicia (Note “indicia” is defined by the dictionary as “distinctive marks: indications” and “indications” is defined as “something that serves to indicate”), 10 and/or 11, indicating a size of the diaper main body and/or indicating a side of the front abdomen portion of the back portion, see CLI, 11 and/or 10, page 2, lines 25-29, page 3, lines 8-9, page 5, lines 23-30, page 6, lines 6-10 and the Figures. Claim 1 also still requires 1) waist elastic members attached in an expanded state, see CLI, as well as 2) the diaper main body being folded over at a fold so as to define a first diaper body portion on one side of the fold and a second diaper body portion on another side of the fold, the first and second diaper body portions being overlaid flat on each other, and the fold defining a fold edge face between the first and second diaper body portions, the fold edge face being exposed and facing outward in a direction substantially parallel to first and second planes of the first and second diaper body portions, at least a portion of the indicia being disposed on the fold edge face, the at least a portion of the indicia being viewable when two or more like folded diaper main bodies are stacked on one another with all the first and second planes of the like folded diaper main bodies parallel to each other, the indicia also being disposed on, and extended to, see CLI supra, both the first and

second portions and the fold extending widthwise across the crotch portion, see CLI supra.

While '845 does not teach waist elastic members and does not explicitly teach a fold as set forth on lines 33 and 23-26 nor first and second body portion overlaying each other at some time having the function, capability or property set forth on lines 27-30, it does teach a article which can have the design of a diaper pant, see, e.g., page 5, lines 10-14 of '845, and at least a portion of the indicia, e.g. 10, disposed on a fold edge face in the folded package condition of the article, the at least a portion of the indicia being viewable when articles have been are taken out of their packages and placed on a shelf or the like, see, e.g., the cited portions of page 6, and the indicia disposed on/extends on, see CLI supra, the front and back portions, see also discussion infra.

However, see also '162, at Figures 1-9C and, e.g., paragraphs 1, 6, 9, 14, 21, 30, 36, 48, 56, 68-73, 76, and '665 at the Figures and, e.g., col. 2, line 56-col. 3, line 62, col. 4, lines 25-39, col. 7, lines 30-34 and col. 2, lines 25-30, i.e. an absorbent article of diaper pants design includes elastic waist elements as well as is folded in half (i.e. the diaper main body being folded over at a fold so as to define a first diaper body portion on one side of the fold and a second diaper body portion on another side of the fold, the first and second diaper body portions being overlaid flat on each other, and the fold defining a fold edge face between the first and second diaper body portions, the fold edge face being exposed and facing outward in a direction substantially parallel to first and second planes of the first and second diaper body portions, and the fold extending widthwise across the crotch portion fold) and attached at its side edges to form pants (i.e. the diaper main body also being folded along such side edges at folds to have flat portions of the diaper main body overlaid on other flat portions of the diaper main body) and/or folding such diaper pants design for packaged/ stored/stacked condition (i.e. folded as discussed supra so as

to have one of a rectangular and a square outline when viewed from a direction normal to the flat portions). Therefore to employ a diaper pants design such as, for example, taught by '162 and '665 as the absorbent article of '845 would be obvious to one of ordinary skill in the art in view of the recognition that such design is known to be used in combination with wetness indicators and/or graphics and the desire of '845 to be an absorbent article with wetness indicators and/or graphics of a diaper pants design. In so doing it is the Examiner's first position that the prior art contemplates the diaper of 1) and 2) supra, see CLI, i.e. the structure set forth on lines 1-19 (It is again noted with regard to the waist and leg-hole elastics, it is not clear what end structure would result from attaching in an expanded state, e.g. could be gathered or not) having a fold as set forth on lines 33 and 23-27, first and second body portion overlaying each other at some time as well as the function, capability or property set forth on lines 27-30 and the indicia also being disposed on, and extended to, see CLI supra, both the first and second portions. In any case, i.e. the Examiner's second position, at the very least, the prior art contemplates the same structure set forth on lines 1-19 having a fold as set forth on lines 33 and 23-27, the first and second body portions overlaying each other at some time and the indicia also being disposed on, and extended to, see CLI supra, both the first and second portions. Therefore, there is sufficient factual evidence that such same structure would necessarily and inevitably include the same capability, structure or function claimed, i.e. of lines 27-30. Finally, i.e. the Examiner's third position, if not already, it would be obvious to store or shelve absorbent articles/diaper pants as contemplated by the prior art stacked on one another as claimed, such as, for example taught by '665, e.g. Figure 4, in view of the recognition that such is storage/space efficient and the desire of such, especially in space conscious/economic/efficient situations such as nursing homes or the like. In so doing,

the prior art would necessarily and inevitably include the capability, structure or function of lines 27-30, see again CLI supra as well as the cited portions of page 6 of '845.

With regard to lines 31-32 of claim 1, note the cited portions of '845 and '162, i.e. the indicia, e.g., 10, has width and length at folds and there are folds in both such portions, e.g., at side edges, at the crotch.

Claim 6: The leg-hole elastic members are disposed so as to not extend into an area in the which the indicia is provided, i.e. see CLI and, e.g., '845, e.g. elastic elements 12 in Figures 1, 3-4 and the indicia 11 and/or 10 with regard thereto.

Claim 10: The indicia, e.g. at least a portion thereof, e.g. the size, is printed on the diaper main body by means of an ink-jet system, see CLI and, e.g., page 3, line 8 of '845, i.e. the size is printed.

Claim 11: An assemblage of diapers folded as claimed in claim 1 are stacked on one another in a stack with all the first and second planes of the diapers parallel to each other, and the indicia being viewable from a side of the stack, see CLI supra and the discussion of claim 1 supra, i.e. a stack of the diapers as claimed in claim 1 with the function, capability or property set forth as set forth on lines 4-5 is contemplated, necessarily and inevitably included or obviously contemplated by the prior art.

Claim 12: The leg-hole elastic member of each of the leg hole sections includes two discontinuous sections, i.e. two section/lines of 12 of each leg hole as seen in Figures 1 and 3-4, with a break area in which at least part of the indicia, e.g. 10, is disposed, as best understood, see CLI supra.

***Response to Arguments***

12. Applicant's remarks have been carefully considered but are either deemed moot in that the issue discussed has not been reraised or deemed not persuasive in light of the discussion supra. Specifically Applicant's remarks on pages 25-26 are now narrower than the claim language, teachings of the prior art and the rejection. For example, the indicia as now claimed can also include structure 10 which is disclosed by '845 as, e.g. an indicator of size, see page 6, lines 6-8 thereof. Furthermore, Figure 4, as set forth on page 3, line 18 is a "diaper". See also page 5, lines 10-14 as well as the other cited portions of '845, i.e. '845 contemplates the features being applicable to other absorbent article designs. Applicant's attention is also invited to MPEP 2106.01, fourth full paragraph, with regard to patentable weight accorded to printed matter.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karin M. Reichle/  
Primary Examiner, Art Unit 3761

September 15, 2009